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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,902	11/26/2003	Paul Richard Heaton	HO-P02375US1	2910
26271 7590 01/05/2007 FULBRIGHT & JAWORSKI, LLP 1301 MCKINNEY SUITE 5100 HOUSTON, TX 77010-3095			EXAMINER GHALI, ISIS A D	
			ART UNIT 1615	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
3 MONTHS			01/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/722,902

Applicant(s)

HEATON ET AL.

Examiner

Isis A. Ghali

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-11 and 13-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-11 and 13-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The receipt is acknowledged of applicants' amendment filed 10/25/2006.

Claims 2 and 12 have been canceled.

Claims 1, 3-11, 13-19 are pending and included in the prosecution.

(A) The following rejections have been overcome by virtue of applicants' amendment and remarks:

(i) The provisional rejection of claims 1-19 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims of copending Application No. 10/282,929 as being 1-47 10/639,139. The rejection has been overcome since the copending application is abandoned.

(ii) The rejection of claims 1, 3-6, 8-11, 13-19 as being anticipated under 35 U.S.C. 102(b) by the article "Antioxidant may improve pet health".

(iii) The rejection of claims 1, 3-6, 8-11, 13-19 as being anticipated under 35 U.S.C. 102(b) by the article "Antioxidant Vitamins in Canine Nutrition".

(iv) The rejection of claims 1, 8-11, 13, 18 and 19 as being anticipated under 35 U.S.C. 102(b) by EP 0 845 216 ('216).

(v) The rejection of claims 1, 8-11, 13, 18 and 19 as being anticipated under 35 U.S.C. 102(b) by EP 0 838 955 ('955).

(B) The following rejections have been discussed in the previous office action, and are maintained for reasons of record:

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-9 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-9 are incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: "producing a foodstuff". The claims are directed to method of producing foodstuff, without actual method steps to produce the foodstuff.

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3. Applicant has failed to traverse this rejection and the response is considered to be acquiescence to the position taken by the examiner. The rejection is therefore repeated for reasons of record. See MPEP 37 CFR 1.111 (b).

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-47 of copending Application No. 10/639,139. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the instant application is fully disclosed in the referenced copending applications and would be covered by any patent granted on the copending applications since the

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referenced copending applications and the instant application are claiming common subject matter as follows: the present claims and the copending conflicted claims are directed to method for treating disorders caused by damage caused by free radical comprising the step of administering to a companion animal a food comprising antioxidants comprising vitamin E, vitamin C, taurine and carotenoids. The disorders claimed by the copending application result from damage by free radicals that cause damage to DNA and consequently damage to different organs and to the immune system. The administration of foodstuff comprising vitamin E will inherently increases the plasma level of vitamin E.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

6. The examiner acknowledges applicants' request to hold the provisional double patenting rejection in abeyance until the conflicting claims are patented. However, the "provisional" double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application unless that "provisional" double patenting rejection is the only rejection remaining in one of the applications.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-19 are rejected under 35 U.S.C. 102(a) as being anticipated by WO 00/44375 ('375).

WO '375 disclosed method to overcome the oxidative stress in cat or dog by providing foodstuff or supplement having antioxidant elements (abstract; page 2, lines 24-27; page 13, lines 7-23). The foodstuff covers all foodstuff or supplement in any form such as solid, semi-solid or liquid (page 3, lines 12-15). The foodstuff comprises 20 mg/400 kcal vitamin C, 50 IU/400 kcal vitamin E, 200 mg/400 kcal taurine; and carotenoids including 0.17 mg/400 kcal lutein, 0.03 mg/400 kcal lycopene and 0.01 mg/400 kcal beta-carotene (page 10, line 25 till page 11, line 14; claims 1-33).

Response to Arguments

9. Applicant's arguments filed 10/25/2006 have been fully considered but they are not persuasive. Applicants traverse this rejection by arguing that nowhere the reference mentions producing or using a foodstuff to reduce the amount of nucleic acid damage.

In response to this argument, it is pointed out to the disclosure of the reference on page 1, lines 8-9, where the reference discloses the effect of free radicals is

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damaging, and on page 2, lines 25-27 the reference discloses that oxidative damage results into end product of protein, and these teachings indicate the free radicals cause damage to the nucleic acid since proteins are built of nucleic acids. In any events, the production or using of the foodstuff is inherent in the teaching of the reference since the foodstuff disclosed by the reference is capable to reducing the oxidative process that damage the protein that is made of nucleic acids.

10. Claims 1, 2, 8-13, 18 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by "Dietary antioxidant in cat and dog nutrition" by Harper.

Harper disclosed provision of dietary antioxidants to cat and dogs including vitamin E, vitamin C, carotenoids and taurine because these antioxidants are major defense against oxidative stress and they protect membrane and cytosolic components against free radical damage. See entire document.

Response to Arguments

11. Applicant's arguments filed 10/25/2006 have been fully considered but they are not persuasive. Applicants traverse this rejection by arguing that nowhere the reference mentions producing or using a foodstuff to reduce the amount of nucleic acid damage.

In response to this argument, it is pointed out to the disclosure of the reference that free radicals are responsible for oxidative damage by damaging the cell membrane, and this teaching indicates the free radicals cause damage to the cells that are built of nucleic acids. The reference also disclosed dietary supplementation of antioxidants. In any events, the production or using of the foodstuff is inherent in the teaching of the

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reference since the foodstuff disclosed by the reference is capable to reducing the oxidative process that damage the cells that are made of nucleic acids.

12. Claims 1, 2, 8-13, 18 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,261,598 ('598).

US '589 discloses animal food formulation comprising antioxidant for cytoprotection, wherein the formulation comprises mixture of beta carotene, lycopene and lutein; and further comprising vitamin E, vitamin C, and taurine (abstract; col.1, lines 27-30, 51-54; col.2, lines 41-46, 53-57, 63). The effect of the composition on the DNA damage is inherent.

Response to Arguments

13. Applicant's arguments filed 10/25/2006 have been fully considered but they are not persuasive. Applicants traverse this rejection by arguing that nowhere the reference mentions producing or using a foodstuff to reduce the amount of nucleic acid damage.

In response to this argument, it is pointed out that the antioxidant effect of the foodstuff disclosed by the reference is inherent in the teaching of the reference since the foodstuff disclosed by the reference is capable to reducing the oxidative process that damage the cells that are made of nucleic acids.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

16. Claims 3-7, 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Dietary antioxidant in cat and dog nutrition" by Harper in view of WO 00/72698 ('698).

Harper teaches provision of dietary antioxidants to cat and dogs including vitamin E, vitamin C, carotenoids and taurine because these antioxidants are major defense against oxidative stress and they protect membrane and cytosolic components against free radical damage. See entire document.

Harper does not teach the amounts of each element of the dietary composition as instantly claimed. Harper does not teach the species of carotenoids as claimed in claims 2 and 13.

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WO '698 teaches feed for companion animals to enhance the immune response and improve the overall health of the animal comprising vitamin E and beta carotene (abstract).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide foodstuff comprising vitamin E, vitamin C, carotenoids and taurine to protect cell membrane and cytosolic components against free radical damage as disclosed by Harper, and replace carotenoids by lutein or beta carotene as disclosed by WO '698, motivated by the teaching of WO '698 that lutein and beta carotene enhance the immune response and improve the overall health of the animal, with reasonable expectation of having foodstuff comprising vitamin E, vitamin C, taurine and lutein or beta carotene that has enhanced protective effect for the cells against damage by free radicals with enhanced immune response and improved over all health of the animal.

The combination of the references does not teach the claimed amounts of the ingredients of the food stuff.

The claimed amounts do not impart patentability to the claims since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

17. Claims 3-7, 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,261,598 ('598).

US '598 teaches animal food formulation comprising antioxidant for cytoprotection, wherein the formulation comprises mixture of beta carotene, lycopene and lutein; and further comprising vitamin E, vitamin C, and taurine (abstract; col.1, lines 27-30, 51-54; col.2, lines 41-46, 53-57, 63).

US '598 does not teach the amounts of each element of the dietary composition as instantly claimed.

The claimed amounts do not impart patentability to the claims since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide foodstuff for cytoprotection comprising vitamin E, vitamin C, carotenoids and taurine as disclosed by US '598, and adjust the amount of each ingredient according to the specific need of the animal, with reasonable expectation of having foodstuff containing the optimal amount desired to protect specific animal.

18. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 00/72698 ('698) in view of "Dietary antioxidant in cat and dog nutrition" by Harper.

WO '698 teaches feed for companion animals to enhance the immune response and improve the overall health of the animal comprising vitamin E and beta carotene (abstract).

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WO '698 does not teach the feed to comprise vitamin C or taurine and the amounts of each ingredient as instantly claimed.

Harper teaches provision of dietary antioxidants to cat and dogs including vitamin E, vitamin C, carotenoids and taurine because these antioxidants are major defense against oxidative stress and they protect membrane and cytosolic components against free radical damage.

Therefore, it would have been to one having ordinary skill in the art at the time of the invention to provide pet food comprising vitamins E and beta carotene as disclosed by WO '698 and further add vitamin C and taurine to the food as disclosed by Harper, motivated by the teaching of Harper that these antioxidants are major defense against oxidative stress and they protect membrane and cytosolic components against free radical damage, with reasonable expectation of having pet food comprising vitamins E and C, beta carotene and taurine that protect cells against damage by free radicals effectively.

The combination of the articles does not teach the amount of different ingredient in the foodstuff. The amount of taurine does not impart patentability to the claims absent evidence to the contrary.

(C) The following new ground of rejections are necessitated by applicants' amendment:

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19. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the article "Antioxidant may improve pet health" in view of the article "Dietary antioxidant in cat and dog nutrition" by Harper.

The article "Antioxidant may improve pet health" teaches pet including dogs need antioxidant in their food or as pills to protect pet against oxygen free radicals. The dog will need 80 IU of vitamin E, which is above 25 IU/400 kcal; 50 mg of vitamin C, which is above 10 mg/400 kcal; and 1.5 of beta-carotene, which is above 0.01 mg/400 kcal. See the entire article.

The article does not disclose taurine in composition and its amount.

Harper teaches provision of dietary antioxidants to cat and dogs including vitamin E, vitamin C, carotenoids and taurine because these antioxidants are major defense against oxidative stress and they protect membrane and cytosolic components against free radical damage.

Therefore, it would have been to one having ordinary skill in the art at the time of the invention to provide pet food comprising vitamins E and C, and beta carotene as disclosed by the article "Antioxidant may improve pet health", and further add taurine to the food as disclosed by Harper, motivated by the teaching of Harper that these antioxidants are major defense against oxidative stress and they protect membrane and cytosolic components against free radical damage, with reasonable expectation of having pet food comprising vitamins E and C, beta carotene and taurine that protect cells against damage by free radicals effectively.

The combination of the articles does not teach the amount of taurine. The amount of taurine does not impart patentability to the claims absent evidence to the contrary.

20. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the article "Antioxidant Vitamins in Canine Nutrition" in view of "Dietary antioxidant in cat and dog nutrition" by Harper.

The article "Antioxidant Vitamins in Canine Nutrition" teaches that the supplemental antioxidants are recommended to canine to protect against damage to cell DNA caused by free radicals. The recommended doses of antioxidants are 80 IU of vitamin E, which is above 25 IU/400 kcal; 50mg of vitamin C, which is above 10 mg/400 kcal; and 4.5 mg beta-carotene, which is above 0.01 mg/400 kcal. See the entire document.

The article "Antioxidant Vitamins in Canine Nutrition" does not disclose taurine in composition and its amount.

Harper teaches provision of dietary antioxidants to cat and dogs including vitamin E, vitamin C, carotenoids and taurine because these antioxidants are major defense against oxidative stress and they protect membrane and cytosolic components against free radical damage.

Therefore, it would have been to one having ordinary skill in the art at the time of the invention to provide pet food comprising vitamins E and C, and beta carotene as disclosed by the article "Antioxidant Vitamins in Canine Nutrition" and further add

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taurine to the food as disclosed by Harper, motivated by the teaching of Harper that these antioxidants are major defense against oxidative stress and they protect membrane and cytosolic components against free radical damage, with reasonable expectation of having pet food comprising vitamins E and C, beta carotene and taurine that protect cells against damage by free radicals effectively.

The combination of the articles does not teach the amount of taurine. The amount of taurine does not impart patentability to the claims absent evidence to the contrary.

21. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 845 216 ('216) in view of "Dietary antioxidant in cat and dog nutrition" by Harper.

EP '216 disclosed animal feed for horses comprising vitamin E, vitamin C, lutein and beta-carotene (abstract; page 3, lines 50-60; page 7, lines 37, 46-52).

EP '216 does not teach the amounts of the ingredients in the foodstuff or the taurine and its amount.

Harper teaches provision of dietary antioxidants to cat and dogs including vitamin E, vitamin C, carotenoids and taurine because these antioxidants are major defense against oxidative stress and they protect membrane and cytosolic components against free radical damage.

Therefore, it would have been to one having ordinary skill in the art at the time of the invention to provide pet food comprising vitamins E and C, and beta carotene as disclosed by EP '216 and further add taurine to the foodstuff as disclosed by Harper,

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motivated by the teaching of Harper that these antioxidants are major defense against oxidative stress and they protect membrane and cytosolic components against free radical damage, with reasonable expectation of having pet food comprising vitamins E and C, beta carotene and taurine that protect cells against damage by free radicals effectively.

The combination of the articles does not teach the amount of different ingredient in the foodstuff. The amount of taurine does not impart patentability to the claims absent evidence to the contrary.

22. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 838 955 ('955) in view of "Dietary antioxidant in cat and dog nutrition" by Harper.

EP '955 disclosed animal feed for fish, cat and dogs comprising vitamin E, vitamin C, lutein and beta-carotene (abstract; page 4, lines 37-39, 42-45, 55-60; page 6, lines 35-55).

EP '955 does not teach the amounts of different ingredients in the foodstuff or the taurine and its amount.

Harper teaches provision of dietary antioxidants to cat and dogs including vitamin E, vitamin C, carotenoids and taurine because these antioxidants are major defense against oxidative stress and they protect membrane and cytosolic components against free radical damage.

Therefore, it would have been to one having ordinary skill in the art at the time of the invention to provide pet food comprising vitamins E and C, and beta carotene as

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disclosed by EP '955 and further add taurine to the foodstuff as disclosed by Harper, motivated by the teaching of Harper that these antioxidants are major defense against oxidative stress and they protect membrane and cytosolic components against free radical damage, with reasonable expectation of having pet food comprising vitamins E and C, beta carotene and taurine that protect cells against damage by free radicals effectively.

The combination of the articles does not teach the amount of different ingredient in the foodstuff. The amount of taurine does not impart patentability to the claims absent evidence to the contrary.

Response to Arguments

23. Applicant's arguments filed 10/25/2006 have been fully considered but they are not persuasive. The main gist of applicants' argument against 103 rejections is that there is no motivation to combine or modify the references.

In response to this argument, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide foodstuff comprising vitamin E, vitamin C, and carotenoids and

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further add taurine to protect cell membrane and cytosolic components against free radical damage, and also one having ordinary skill in the art would have replaced carotenoids by lutein or beta carotene, with reasonable expectation of having foodstuff comprising vitamin E, vitamin C, taurine and lutein or beta carotene that has enhanced protective effect for the cells against damage by free radicals with enhanced immune response and improved over all health of the animal. Motivations are discussed in the rejections.

The cited references show that it was well known in the art at the time of the invention to use the claimed ingredients in compositions that reduce oxidative damage. It is well known that it is prima facie obvious to combine two or more ingredients each of which is taught by the prior art to be useful for the same purpose in order to form a third composition which is useful for the same purpose. The idea for combining them flows logically from their having been used individually in the prior art. In re Pinten, 459 F.2d 1053, 173 USPQ 801 (CCPA1972); In re Susi, 58 CCPA 1074, 1079-80) 440 F.2d 442, 445; 169 USPQ 423, 426 (1971); In re Crockett, 47 CCPA 1018, 1020-21; 279 F.2d 274, 276-277; 126 USPQ 186, 188 (1960).

No patentable invention resides in combining old ingredients of known properties where the results obtained thereby are no more than the additive effect of the ingredients. See In re Sussman, 1943 C.D. 518; In re Huellmantel 139 USPQ 496; In re Crockett 126 USPQ 186.

In considering the disclosure of the reference, it is proper to take into account not only the specific teachings of the reference but also the inferences which one skilled in

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the art would reasonably be expected to draw therefrom. *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). The rational to modify or to combine the prior art does not have to be expressly stated in the prior art; the rational may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art. The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve different problem. It is not necessary that the prior art suggest the combination or modification to achieve the same advantage or result discovered by applicant. *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972).

Finally, a conclusion of obviousness under 35 U.S.C. 103 (a) does not require absolute predictability, only a reasonable expectation of success; and references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosure. *In re Bozek*, 163 USPQ 545 (CCPA 1969).

In the light of the foregoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the claims would have been obvious within the meaning of 35 U.S.C. 103 (a).

Conclusion

24. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isis A. Ghali whose telephone number is (571) 272-0595. The examiner can normally be reached on Monday-Thursday, 7:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Isis A Ghali
Primary Examiner
Art Unit 1615

IG

Isis Ghali